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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,659	11/29/2001	Gerald E. Bennington	UV-133 CONT3	5782
1473	7590	07/22/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			LEE, MICHAEL	
			ART UNIT	PAPER NUMBER
			2614	
			DATE MAILED: 07/22/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/997,659

Applicant(s)

BENNINGTON ET AL.

Examiner

M. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/17/04 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter et al. (4,751,578) in view of Young (4,706,121).

Regarding claims 1, 11, Reiter shows a displaying step for displaying at least a substantial portion of a program in at least a portion of the display (col. 6, lines 29-38), a displaying step for displaying at least one interactive program listing on the display simultaneously with the at least a substantial portion of the program (col. 6, lines 29-38), and an allowing step for allowing the user to select the at least one interactive program listing (col. 5, lines 34-36, col. 6, lines 47-54). But Reiter does not specify the displaying

step for displaying a second program corresponding to the selected interactive program listing in at least a portion of the display, in response to receiving the selection from the user as claimed. Young, from the similar field of endeavor, teaches the displaying step as claimed (col. 11, lines 62-65). Young discusses the problem of conventional manual television channel selection (col. 2, lines 36-55). Reiter adapts such manual channel selection method (col. 4, lines 23-28). As pointed by Young, manual channel selection can be very laborious and cumbersome when the number of television channels is getting exponentially large. However, by employing the menu channel selection method, the need of manual channel selection and the problem incurred by it are eliminated (Young, col. 3, lines 21-24). Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the menu selection feature of Young into Reiter so that the manual channels problems can be eliminated.

Regarding claims 2, 12, 22, the television schedule inherently includes a program title and a program channel (col. 4, lines 40-41).

Regarding claims 3, 13, 23, see col. 10, lines 50-59.

Regarding claims 4, 14, 24, Reiter and Young both shows a user control means (32 in Reiter and 116 in Young).

Regarding claims 5, 6, 15, 16, 25, 26, Reiter teaches that the program listing can be displayed in a window format (col. 2, lines 23-29) but does not specify the relative size in between the first portion than the second portion as claimed. In any event, it is well known that window display size is usually user configurable. To change the size of

the window would have been considered an obvious design choice and would have been obvious to one of ordinary skill in the art.

Regarding claims 7-10, 17-20, 17-30, Reiter does not specify the reminder message as claimed. Young teaches such message (col. 15, lines 20-68, col. 20, lines 40-49). By using the reminder message, the user can be properly notified when a scheduled program is about to begin. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the reminder feature of Young into Reiter so that the user would not have to miss a single program.

Regarding claim 21, in addition of above, Reiter further shows a video display controller (64, 70), and a microprocessor (60), which is being programmed to carry out the functions as recited above (col. 7, lines 60-68).

4. The Declaration under 37 CFR 1.132 filed on 5/27/1997 is insufficient to overcome the rejection of claims 1-30 based upon Reiter et al. (4,751,578) in view of Young (4,706,121) as set forth in the last Office action because the objective evidence, copying and commercial success of applicant's claimed invention do not commensurate with the scope of the claims.

5. In accordance with the MPEP, objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims...in order to be commensurate is scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features (MPEP 716.03(a)). In the declaration, applicant discussed the evidence of the "Browse" feature in the EPG.

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However, nowhere it discussed the claimed invention—displaying a second program corresponding to the selected interactive program listing in at least a portion of the display, in response to receiving the selection from the user. None of the evidence (Exhibits A-I) suggests the display feature as now claimed. The Exhibits A, C, D and E as discussed declaration do not show the second program display limitation as claimed, which has to be displayed simultaneously with a background image and a program listing. In fact, each of the Exhibits only shows a program browse window in which a program can be tuned by the viewer by operating a button. However, none of them mentions a second program window. Since applicant fails to provide probative evidence, the 1.132 Declaration is insufficient to overcome the prior art rejection and hence, the rejection sustains.

6. It states that the claimed subject matter solved a problem that was long standing in the art as discussed with respect to Exhibit A. However, the objective evidence in Exhibit A is not the same invention as now claimed as discussed above. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

7. It states that several commercial IPG providers have copied the claimed subject matter and thus the copying weighs against a conclusion of obviousness of applicant's claims. As discussed above, the alleged IPG providers do not show the second program display limitation as now claimed. Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other

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manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985).

8. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Response to Arguments***

9. Applicant's arguments filed 5/17/04 have been fully considered but they are not persuasive as set forth above.

10. Please provide a Form PTO-1449 of IDS submitted on 5/17/04 because it is missing from the file.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number is **703-305-4743**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Miller**, can be reached at **703-305-4795**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



**M. Lee**  
**Primary Examiner**  
**Art Unit 2614**

July 21, 2004